

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

APPEAL BRIEF FOR THE APPELLANT

Ex parte Jan CHIPCHASE *et al.*

CUSTOMISATION OF AN ELECTRONIC DEVICE

Serial No. 10/562,566

Confirmation No. 7877

Appeal No.:

Group Art Unit: 2617

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In re the Appellant:

Jan CHIPCHASE, *et al.*

Appeal No.:

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Group Art Unit: 2617

Filed: March 6, 2006

Examiner: Fred A. Casca

Confirmation No. 7877

For: CUSTOMISATION OF AN ELECTRONIC DEVICE

BRIEF ON APPEAL

November 18, 2011

I. INTRODUCTION

This is an appeal from the final rejection set forth in an Official Action dated January 25, 2011, finally rejecting claims 1, 3-10 and 50-61, all of the claims pending in this application, as being unpatentable over Kelley, Shteyn and Duri. A Request for Reconsideration was timely filed on April 25, 2011. An Advisory Action was issued on May 16, 2011, indicating that applicant's arguments filed on April 25, 2011 have been considered but are not persuasive. A Notice of Appeal and Pre-Appeal Brief Request for Review were timely filed on May 25, 2011, with petition for Extension of Time. A Notice of Panel Decision from Pre-Appeal Brief Review was issued on October 18, 2011, indicating that the rejections of claims 1, 3-10 and 50-61 were maintained. Accordingly, this Appeal Brief is being timely filed within one month of the Notice of Panel Decision.

II. REAL PARTY IN INTEREST

The real party in interest in this application is Nokia Corporation of Espoo, Finland, by virtue of an Assignment by the inventors to Nokia Corporation, which assignment was recorded at Reel 017665, Frame 0263, on March 6, 2006.

III. STATEMENT OF RELATED APPEALS AND INTERFERENCES

There are no known related appeals and/or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

IV. STATUS OF CLAIMS

Claims 1, 3-10 and 50-61, all of the claims pending and under consideration in the present application are the subject of this appeal. Claims 1, 3, 4-10 and 50-61 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable as obvious over U.S. Patent No. 6,728,712 of Kelley *et al.* (“Kelley”) in view of U.S. Patent No. 6,782,253 of Shteyn *et al.* (“Shteyn”), and further in view of U.S. Patent Publication No. 2002/0156832 of Duri *et al.* (“Duri”). Claims 2 and 11-13 have been cancelled. Claims 14-49 have been withdrawn from consideration.

V. STATUS OF AMENDMENTS

The Response filed April 25, 2011, did not include any amendments to the claims. Thus, the claims stand as they were presented prior to the Office Action dated January 25, 2011.

VI. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1, upon which claims 3-7, depend, is directed to an apparatus (see, for example, mobile electronic device 111, Figures 1 and 2, page 11, lines 5-16) including at least one processor (see, for example, Figure 2, controller 214, page 15, lines 7-30) and at least one memory including computer program code (see, for example, Figure 2, controller 214 and memory 212, page 13, lines 1-8). The at least one memory and the computer program code are configured to, with the at least one processor, cause the apparatus to store a set of tags and for each tag, store an associated network address (see, for example, page 5, lines 27-29). Each tag corresponds to a service and the associated network address corresponds to a service provider of the service (see, for example, page 6, lines 21-22, page 17, lines 16-19, and page 18, lines 2-5). The at least one memory and the computer program code are also configured to, with the at least one processor, cause the apparatus to provide a user interface that enables a user to select one of the tags and cause the apparatus to initiate a connection to the network address associated with the tag (see, for example, page 5, line 30, to page 6, line 1). The at least one memory and the computer program code are further configured to, with the at least one processor, cause the apparatus to estimate the location of the apparatus (see, for example, page 6, lines 5-6). The at least one memory and the computer program code are additionally configured to, with the at least one processor, cause the apparatus to communicate with the network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location (see, for example, page 6, lines 6-9). The at least one

memory and the computer program code are also configured to, with the at least one processor, cause the apparatus to automatically alter the network address associated with the tag in response to the communication received from the network (see, for example, page 6, lines 1-3).

Claim 8, upon which claims 9 and 10 depend, is directed to an apparatus (see, for example, mobile electronic device 111, Figures 1 and 2, page 11, lines 5-16) including at least one processor (see, for example, Figure 2, controller 214, page 15, lines 7-30) and at least one memory including computer program code (see, for example, Figure 2, controller 214 and memory 212, page 13, lines 1-8). The at least one memory and the computer program code are configured to, with the at least one processor, cause the apparatus to store a set of tags and for each tag, store an associated network address (see, for example, page 5, lines 27-29). Each tag corresponds to a service and the associated network address corresponds to a service provider of the service (see, for example, page 6, lines 21-22, page 17, lines 16-19, and page 18, lines 2-5). The at least one memory and the computer program code are also configured to, with the at least one processor, cause the apparatus to communicate at least one instruction containing a tag and an associated network address with at least one mobile communication terminal (see, for example, page 5, line 30, to page 6, line 1). The at least one mobile communication terminal is configured to communicate with the apparatus to request that the apparatus transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location (see, for example, page 6, lines 6-9).

Claim 50, upon which claims 51-56 depend, is directed to a method including storing a set of tags and for each tag, storing an associated network address (see, for example, page 5, lines 27-29). Each tag corresponds to a service and the associated network address corresponds to a service provider of the service (see, for example, page 6, lines 21-22, page 17, lines 16-19, and page 18, lines 2-5). The method also includes providing a user interface that enables a user to select one of the tags and cause a mobile communication terminal to initiate a connection to the network address associated with the tag (see, for example, page 5, line 30, to page 6, line 1). The method further includes estimating the location of the mobile communication terminal (see, for example, page 6, lines 5-6). The method additionally includes communicating with the network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location (see, for example, page 6, lines 6-9). The method also includes automatically altering the network address associated with the tag in response to the communication received from the network (see, for example, page 6, lines 1-3).

Claim 57, upon which claims 58 and 59 depend, is directed to a method including storing a set of tags and for each tag, storing an associated network address (see, for example, page 5, lines 27-29). Each tag corresponds to a service and the associated network address corresponds to a service provider of the service (see, for example, page 6, lines 21-22, page 17, lines 16-19, and page 18, lines 2-5). The method also includes communicating at least one instruction containing a tag and an associated network address

with at least one mobile communication terminal (see, for example, page 5, line 30, to page 6, line 1). The at least one mobile communication terminal is configured to communicate with a network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location (see, for example, page 6, lines 6-9).

Claim 60 is directed to a computer program embodied on a non-transitory computer-readable storage medium, the program being configured to control a processor to store a set of tags and for each tag, store an associated network address (see, for example, page 5, lines 27-29). Each tag corresponds to a service and the associated network address corresponds to a service provider of the service (see, for example, page 6, lines 21-22, page 17, lines 16-19, and page 18, lines 2-5). The program is also configured to control a processor to provide a user interface that enables a user to select one of the tags and cause a mobile communication terminal to initiate a connection to the network address associated with the tag (see, for example, page 5, line 30, to page 6, line 1). The program is further configured to control a processor to estimate the location of the mobile communication terminal (see, for example, page 6, lines 5-6). The program is additionally configured to control a processor to communicate with the network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location (see, for example, page 6, lines 6-9). The program is also configured to control a processor to automatically alter the network address associated with the tag in response to the communication received from the network (see, for example,

page 6, lines 1-3).

Claim 61 is directed to a computer program embodied on a non-transitory computer-readable storage medium, the program being configured to control a processor to store a set of tags and for each tag, store an associated network address (see, for example, page 5, lines 27-29). Each tag corresponds to a service and the associated network address corresponds to a service provider of the service (see, for example, page 6, lines 21-22, page 17, lines 16-19, and page 18, lines 2-5). The program is also configured to control a processor to communicate at least one instruction containing a tag and an associated network address with at least one mobile communication terminal (see, for example, page 5, line 30, to page 6, line 1). The at least one mobile communication terminal is configured to communicate with a network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location (see, for example, page 6, lines 6-9).

VII. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The grounds for rejection to be reviewed on appeal are the precise grounds of rejection exactly as set forth at pages 2-14 of the Office Action mailed January 25, 2011. Those rejections may be summarized as follows: claims 1, 3-10, and 50-61 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable as obvious over U.S. Patent No. 6,728,712 of Kelley *et al.* (“Kelley”) in view of U.S. Patent No. 6,782,253 of Shteyn *et al.* (“Shteyn”), and further in view of U.S. Patent Publication No. 2002/0156832 of Duri *et al.* (“Duri”).

VIII. APPELLANT’S ARGUMENTS

A. Claims 1, 3-10, and 50-61 are Non-Obvious in view of Kelley, Shteyn, and Duri

Claims 1, 3-10, and 50-61 were rejected under 35 U.S.C. §103(a) as being allegedly unpatentable as obvious over U.S. Patent No. 6,728,712 of Kelley *et al.* (“Kelley”) in view of U.S. Patent No. 6,782,253 of Shteyn *et al.* (“Shteyn”), and further in view of U.S. Patent Publication No. 2002/0156832 of Duri *et al.* (“Duri”).

The Office Action took the position that Kelley discloses many features of the claims, but argued that Kelley does not disclose “estimate the location of the apparatus, communicate with the network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location, and automatically alter the network address associated with the tag in response to the communication received from the network.” The Office Action alleged that Shteyn discloses these features.

However, the Office Action acknowledged that the combination of Kelley and Shteyn fails to disclose “each tag corresponds to a service” and “wherein the associated network address corresponds to a service provider of the service.” The Office Action alleged that Duri discloses these features. Accordingly, the Office Action alleged that the claims are obvious in view of the combined teachings of the prior art. Applicants respectfully traverse this rejection as applied to each claim.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of

presenting a *prima facie* case of obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). “[R]jections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 [78 USPQ2d 1329] (CA Fed. 2006) (quoted in *KSR Int’l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007)).

A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See *In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972); *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442-43 (Fed. Cir. 1991) (explaining the three elements of a *prima facie* case of obviousness include: (1) motivation for the combination, (2) a reasonable expectation of success, and (3) a disclosure of all the claim elements by the prior art). See also *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

As MPEP 2141 explains:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed.

Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The Examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption, or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). The Federal Circuit has repeatedly cautioned against employing hindsight by using Appellants' disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Prods. Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing *In re Fritch*, 972 F.2d 1260, 1265,

23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” *Dembiczak*, 175 F.3d at 999-1000, 50 USPQ2d at 1617, *citing McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993). Further, as pointed out by the Federal Circuit, the scope of the claim must be the first determination. “[T]he name of the game is the claim.” *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). It is respectfully submitted that the high standard with respect to rejections for alleged obviousness has not been met, and consequently there is no *prima facie* rejection for obviousness.

1. Claim 1

Claim 1 recites, in part, “estimate the location of the apparatus, communicate with the network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location, and automatically alter the network address associated with the tag in response to the communication received from the network.” Applicants respectfully submit that the combination of Kelley and Shteyn fails to disclose or suggest at least these features of claim 1.

Kelley generally discusses “software for updating desired inter- or intra-net addresses at a client computer” (column 1, lines 9-10). “Database 14 is conventionally

referred to as a bookmark database, having addresses of often-used web pages or files 26, 28 having different addresses (URLs) and accessible 24 through network server 18. As will be explained further, database 16 contains the updated addresses of the files listed on the client bookmark, and the updated addresses are used to make changes to the bookmark database 14” (column 4, lines 8-15, of Kelley).

As noted above, the Office Action acknowledged that “Kelley does not specifically disclose estimate the location of the apparatus, communicate with the network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location, and automatically alter the network address associated with the tag in response to the communication received from the network in the format claimed.” Thus, instead of relying only on Kelley, the Office Action relied on the following portions of Shteyn: Figures 1-6; Column 1, lines 39-62; Column 2, lines 6-28 and 47-56; Column 3, lines 1-15; and Column 4, lines 17-45. Applicants respectfully submit that Shteyn fails to remedy Kelley’s deficiencies by teaching or suggesting the above-recited features of claim 1.

Shteyn generally relates to a mobile micro portal. In Shteyn, a geographic region has a network of beacons. Each beacon transmits a short-range facilitation signal for receipt on a user’s mobile communication device. The facilitation signal initiates association of the facilitation signal with a service and conditionally alerts the user to the service via the device, dependent on a user profile. The user-profile and the association between facilitation signal and service are user-programmable in Shteyn.

The Office Action argued that “It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the invention of Kelly [sic] such that the apparatus of Kelley would be able to estimate its location, for the purposes of letting the network [be] informed of its location, and consequently allowing the network to alter the network address associated with the tag and thus providing proper services to the user.” Applicants respectfully disagree with the Office Action’s conclusion of obviousness.

The Office Action has alleged that the “tags” of Kelley are the “bookmarks” of Kelley’s system. The bookmarks of Kelley’s system identify web sites, not the location of the user. Furthermore, the user’s location has no impact on the user’s bookmarks in Kelley. Accordingly, it would not be necessary to update the user’s location or to alter a network address associated with a bookmark in order to “provide proper services” to a user of Kelley’s system.

Shteyn mentions bookmarks at column 10, lines 46-50. However, Shteyn does not suggest or even hint at the idea of altering network addresses associated with the bookmarks. Instead, in the context of column 10, lines 46-50, the bookmarks are used to identify which services should be announced to a user, since bookmarks may indicate the preferences of a user.

Shteyn also mentions bookmarks in the “background” section of Shteyn, at column 2, lines 16-28:

The Cooltown Museum and Bookstore offer visitors a Web-enhanced experience. As visitors tour the museum, their portable digital assistant (PDA) can receive Web URLs from

wireless "beacons". These beacons are small infrared transceivers located close to pictures or sculptures; the URLs link into a Web of information about the items. Using the PDA's Web browser, visitors can read or hear about the artist or the work and about related art works in the museum. The URLs can also be stored as bookmarks for further study or they can be used to select reproductions of the artwork from the museum's online store. The museum staff uses the same URLs for inventory control as the URLs point to the object's point of Web presence.

This reference to bookmarks, however, in no way hints or suggests at the idea of changing a network address associated with a bookmark. Instead, it merely indicates the possibility of providing the user with URLs that can be stored as bookmarks. No subsequent updating or changing of these URLs is hinted at.

Furthermore, the proposal at column 2, lines 16-28, of Shteyn is directly taught away from by Shteyn at column 2, lines 31-32 and 56-67. Instead, as explained at column 3, lines 1-15, Shteyn's system provides information to users within range of a beacon based on the user's interests.

URLs are mentioned again in Shteyn at column 7, lines 3-5, where it is mentioned that a mobile device can use predefined URL to access a web merchant and perform a search. There is not, however, any suggestion to change this predefined URL.

URLs are mentioned yet again in Shteyn at column 8, lines 6-11, where it is explained that the look-up service can use rules for creating a search URL from a basic "service URL" combined with two fields. However, Shteyn does not suggest altering any stored URL or any bookmark.

The other references to URL in Shteyn are similarly irrelevant to the claimed subject matter (see column 8, lines 51-52; column 9, lines 64-65; column 10, lines 14-27, and claim 7 of Shteyn). These other portions of Shteyn merely refer to the fact that URL information can point a user to local's service directory or can serve as an identifier for an on-line store. Neither Kelley nor Shteyn either hints or suggests that the network address associated with a bookmark should be changed, and certainly Kelley and Shteyn do not teach or suggest that such a change should be made contingent upon performing a location estimate.

Accordingly, the combination of Kelley and Shteyn cannot disclose or suggest, at least, "estimate the location of the apparatus, communicate with the network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location, and automatically alter the network address associated with the tag in response to the communication received from the network," as recited in claim 1.

Additionally, claim 1 recites "wherein each tag corresponds to a service and wherein the associated network address corresponds to a service provider of the service." The Office Action acknowledged that "Kelley does not specifically disclose each tag corresponds to a service[] and wherein the associated network address corresponds to a service provider of the service." Accordingly, the Office Action cited Duri to remedy these deficiencies of Kelley.

Duri generally relates to a method and apparatus for dynamic bookmarks with attributes. In Duri, in response to detecting a service domain with a dynamic bookmark

service, a client device sends a request containing criteria identifying a dynamic bookmark to the service domain. The dynamic bookmark contains attributes or criteria that may be used to bind or locate regular bookmarks having similar attributes or criteria. The request is received by a server, which queries a data structure using the criteria for a bookmark, corresponding to or matching the criteria, to generate a result. This result is returned in a response to the client. The client processes any bookmarks received in the response, wherein any bookmarks returned in the request are bookmarks matching the dynamic bookmark.

At paragraphs [0022]-[0025], Duri explains the operation of server 104 and client 114. In this section Duri explains the difference between a “bookmark” and a “dynamic bookmark.”

In these examples, a bookmark, also called a regular bookmark, in contrast to a dynamic bookmark, consists of a name (string) and a universal resource locator (URL). As used herein, a dynamic bookmark consists of a set of attributes or criteria that dynamically bind to a set of zero or more regular bookmarks that have been augmented with similar attributes or criteria. The dynamic bookmark is located or stored within client 114. The dynamic binding process is performed by a dynamic bookmark server, which may be implemented using server 104. Server 104 receives a request from client 114 in which the request includes the set of attributes or criteria. Server 104 matches the attributes of the dynamic bookmark with those of the augmented bookmarks contained in a bookmarks and attributes database, which may be located within a storage device at server 104 or a remote storage device, such as storage unit 106.

It should be apparent from this description that a “dynamic bookmark” is not a

bookmark at all, but is rather information that can be used to obtain a bookmark. Indeed, unlike a regular bookmark, the dynamic bookmark of Duri does not have a URL.

The features of Kelley, Shteyn, and Duri have been selected in hindsight based on the claims, but they do not make sense as a combination with one another. The Office Action began with Kelley and combined Kelley with Shteyn, and then added Duri. However, even the simpler combination of Kelley and Shteyn is unclear. The characteristics of a system resulting from the combination of Kelley and Shteyn are entirely unclear, because the Office Action has not clearly explained how the references would be combined, or even combinable.

For example, while Kelley relates to a system for updating Internet address changes, Shteyn has nothing to do with such issues. Instead, Shteyn relates to a way for local provider of goods or services to “push” information to a user, while allowing the user to filter out the information that is unwanted (see Column 4, lines 18-45, of Shteyn). Neither Kelley nor Shteyn provide a teaching or suggestion of an interrelation between the problems addressed by each reference, and there is no obvious way to combine the two systems.

The Office Action stated that the motivation for the combination of Kelley and Shteyn would have been as follows:

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the invention of Kelly [sic] such that the apparatus of Kelley would be able to estimate its location, for the purposes of letting the network [be] informed of its location, and consequently allowing the

network to alter the network address associated with the tag and thus providing proper services to the user.

There is not, however, any reason to suppose that Kelley cannot provide “proper services to the user” without estimating a location and/or altering the network address associated with a tag (even assuming that Shteyn taught the location estimation and network address alteration as claimed, which it does not, as explained above).

Likewise, the Office Action stated that the motivation for the combination of Kelly and Duri would have been as follows:

It would have been obvious to a person of ordinary skill in the art at the time of invention to modify the invention of Kelley in the format claimed for the purpose of providing an efficient communication system.

There is, however, no reason to suppose that Kelley provides an inefficient system or that adding features from Duri can or would improve the efficiency of Kelley’s system. Moreover, it is not even clear what changes the Office Action would suggest making to Kelley’s system.

Rather than following the Supreme Court’s instructions in *KSR* to provide clearly articulated reasoning with rational underpinnings for the conclusion of obviousness, the present rejection simply represents an attempted reconstruction of the invention in hindsight based not on the knowledge of one of ordinary skill in the art at the time of the invention but on the disclosure of the present application.

There is no clear way that the references *could* be combined, even if one of ordinary skill in the art were (for some unknown reason) to desire to make such a combination. In

Kelley, a change in the URL is made when a web site owner updates the URL. In Duri, however, the dynamic bookmark has no URL. Moreover, in Shteyn there is no updating of a URL (nor of a “dynamic bookmark”). Accordingly, one of ordinary skill in the art would not have any reasonable expectation of success of creating a working combination of Kelley, Shteyn, and Duri without undue experimentation.

2. Claim 8

Claim 8 has its own scope but, similar to claim 1, recites: “wherein each tag corresponds to a service and wherein the associated network address corresponds to a service provider of the service” and “a communication that automatically alters the network address associated with a tag in dependence on the estimated location.” Claim 8 was rejected for “the same reasons” as claim 1. Thus, the discussion above also serves to show the patentability of claim 8.

3. Claim 50

Claim 50 has its own scope but, similar to claim 1, recites: “wherein each tag corresponds to a service and wherein the associated network address corresponds to a service provider of the service” and “a communication that automatically alters the network address associated with a tag in dependence on the estimated location.” Claim 50 was rejected for similar reasons to claim 1. Thus, the discussion above also serves to show the patentability of claim 50.

4. Claim 57

Claim 57 has its own scope but, similar to claim 1, recites: “wherein each tag

corresponds to a service and wherein the associated network address corresponds to a service provider of the service” and “a communication that automatically alters the network address associated with a tag in dependence on the estimated location.” Claim 57 was rejected for similar reasons to claim 1. Thus, the discussion above also serves to show the patentability of claim 57.

5. Claim 60

Claim 60 has its own scope but, similar to claim 1, recites: “wherein each tag corresponds to a service and wherein the associated network address corresponds to a service provider of the service” and “a communication that automatically alters the network address associated with a tag in dependence on the estimated location.” Claim 60 was rejected for similar reasons to claim 1. Thus, the discussion above also serves to show the patentability of claim 60.

6. Claim 61

Claim 61 has its own scope but, similar to claim 1, recites: “wherein each tag corresponds to a service and wherein the associated network address corresponds to a service provider of the service” and “a communication that automatically alters the network address associated with a tag in dependence on the estimated location.” Claim 61 was rejected for “the same reasons” as claim 57. Thus, the discussion above also serves to show the patentability of claim 61.

7. Claim 3

Claim 3 depends from and further limits claim 1. Thus, claim 3 is patentable for at

least the reasons set forth above. Claim 3 further recites: “wherein the user interface has a mode where a user can cause the apparatus to communicate with the network to request transmission of the communication automatically altering the network address associated with the tag.” The Office Action cited column 1, lines 46-50, of Kelley regarding these features. The cited paragraph of Kelley, however, merely mentions verification of updates of desired inter- or intranet addresses. There is no discussion of requesting a transmission of a communication that automatically alters a network address associated with a tag. Accordingly, for these additional reasons, the rejection of claim 3 should be reversed.

8. Claim 4

Claim 4 depends from and further limits claim 3. Thus, claim 4 is patentable for at least the reasons set forth above. This claim is being separately argued to preserve Applicants’ right to have the claim separately considered, particularly if the grounds of rejection shift during the appeal.

9. Claim 5

Claim 5 depends from and further limits claim 4. Thus, claim 5 is patentable for at least the reasons set forth above. Claim 5 further recites: “detect a service provider of the network to which the apparatus is connecting, and to communicate with the network in response to a change in the service provider.” The Office Action cited column 1, lines 43-45, of Kelley regarding these features. The cited paragraph of Kelley, however, merely mentions updating desired inter- or intranet addresses without prompting from the client computer. There is no discussion of communicating with the network in response to a

change in the service provider. Accordingly, for these additional reasons, the rejection of claim 5 should be reversed.

10. Claim 6

Claim 6 depends from and further limits claim 1. Thus, claim 6 is patentable for at least the reasons set forth above. Claim 6 further recites: “wherein the tag and its associated network address are stored in the memory as a dynamic service card.” The Office Action alleged that a dynamic service card is an obvious design choice with respect to a database. However, there is no evidence of record that a dynamic service card was considered an equivalent to a database at the time the invention was made. The Office Action argued that no particular problems could be solved and that Kelley’s database would perform equally well. Such an argument, however, is an argument against obviousness. If there is no reason to modify Kelley, the modification is not obvious. Moreover, the use of design service cards is different from the use of databases generally, as can be seen in the present application’s specification (see, for example, pages 17-19). Accordingly, for these additional reasons, the rejection of claim 6 should be reversed.

11. Claim 7

Claim 7 depends from and further limits claim 1. Thus, claim 7 is patentable for at least the reasons set forth above. Claim 7 further recites: “wherein the network address associated with the tag comprises ... a uniform resource locator,” which the Office Action alleged is disclosed by the reference to URL in Kelley at column 1, lines 12-15. However, the cited reference is to Kelley’s discussion of a conventional bookmark file. Thus, as

explained above, this is an incompatible embodiment with that of Duri, and consequently the proposed combination is non-obvious. Accordingly, for these additional reasons, the rejection of claim 7 should be reversed.

12. Claim 9

Claim 9 depends from and further limits claim 8. Thus, claim 9 is patentable for at least the reasons set forth above. This claim is being separately argued to preserve Applicants' right to have the claim separately considered, particularly if the grounds of rejection shift during the appeal.

13. Claim 10

Claim 9 depends from and further limits claim 8. Thus, claim 9 is patentable for at least the reasons set forth above. This claim is being separately argued to preserve Applicants' right to have the claim separately considered, particularly if the grounds of rejection shift during the appeal.

14. Claim 51

Claim 51 depends from and further limits claim 50. Thus, claim 51 is patentable for at least the reasons set forth above. This claim is being separately argued to preserve Applicants' right to have the claim separately considered, particularly if the grounds of rejection shift during the appeal.

15. Claim 52

Claim 52 depends from and further limits claim 51. Thus, claim 52 is patentable for at least the reasons set forth above. Claim 52 further recites: "wherein the user interface has

a mode where a user can cause the apparatus to communicate with the network to request transmission of the communication automatically altering the network address associated with the tag.” The Office Action cited “screen” in Figures 1 and 2 of Kelley. However, Kelley has no discussion of requesting a transmission of a communication that automatically alters a network address associated with a tag. Accordingly, for these additional reasons, the rejection of claim 52 should be reversed.

16. Claim 53

Claim 53 depends from and further limits claim 52. Thus, claim 53 is patentable for at least the reasons set forth above. This claim is being separately argued to preserve Applicants’ right to have the claim separately considered, particularly if the grounds of rejection shift during the appeal.

17. Claim 54

Claim 54 depends from and further limits claim 53. Thus, claim 54 is patentable for at least the reasons set forth above. Claim 54 further recites: “detecting a service provider of the network to which the apparatus is connecting, and to communicate with the network in response to a change in the service provider.” The Office Action cited Figure 4 and column 3, lines 11-65, of Kelley regarding these features. The cited passage of Kelley, however, merely mentions updating desired inter- or intranet addresses with or without prompting from the client computer. There is no discussion of communicating with the network in response to a change in the service provider. Accordingly, for these additional reasons, the rejection of claim 54 should be reversed.

18. Claim 55

Claim 55 depends from and further limits claim 50. Thus, claim 55 is patentable for at least the reasons set forth above. Claim 55 further recites: “wherein the tag and its associated network address are stored in the memory as a dynamic service card.” The Office Action referred back to the rejection of claim 1, but probably intended to refer to the rejection of claim 6, in which the Office Action alleged that a dynamic service card is an obvious design choice with respect to a database. However, there is no evidence of record that a dynamic service card was considered an equivalent to a database at the time the invention was made. The Office Action argued that no particular problems could be solved and that Kelley’s database would perform equally well. Such an argument, however, is an argument against obviousness. If there is no reason to modify Kelley, the modification is not obvious. Moreover, the use of design service cards is different from the use of databases generally, as can be seen in the present application’s specification (see, for example, pages 17-19). Accordingly, for these additional reasons, the rejection of claim 55 should be reversed.

19. Claim 56

Claim 56 depends from and further limits claim 50. Thus, claim 56 is patentable for at least the reasons set forth above. Claim 56 further recites: “wherein the network address associated with the tag comprises ... a uniform resource locator,” which the Office Action alleged (in the rejection of claim 7, to which the rejection of claim 56 refers) is disclosed by the reference to URL in Kelley at column 1, lines 12-15. However, the cited reference

is to Kelley's discussion of a conventional bookmark file. Thus, as explained above, this is an incompatible embodiment with that of Duri, and consequently the proposed combination is non-obvious. Accordingly, for these additional reasons, the rejection of claim 5 should be reversed.

20. Claim 58

Claim 58 depends from and further limits claim 57. Thus, claim 58 is patentable for at least the reasons set forth above. This claim is being separately argued to preserve Applicants' right to have the claim separately considered, particularly if the grounds of rejection shift during the appeal.

21. Claim 59

Claim 59 depends from and further limits claim 57. Thus, claim 59 is patentable for at least the reasons set forth above. This claim is being separately argued to preserve Applicants' right to have the claim separately considered, particularly if the grounds of rejection shift during the appeal.

Conclusion

For all of the above noted reasons, it is strongly contended that certain clear differences exist between the present invention as claimed in claims 1, 3-10 and 50-61 and the prior art relied upon by the Examiner. It is further contended that these differences are more than sufficient that the present invention would not have been obvious to a person having ordinary skill in the art at the time the invention was made.

In particular, Applicants respectfully submit that this rejection contains at least two clear errors: (1) the rejection is plainly an inappropriate use of hindsight reconstruction without proper motivation in the knowledge of one of ordinary skill in the art, and (2) “a communication that automatically alters the network address associated with a tag in dependence on the estimated location” (as recited in the present claims) is missing in the prior art.

Clear Error 1: Rejection is Plainly an Unmotivated Hindsight Reconstruction

Kelley discusses a client’s bookmark database of URLs of files on a network. To avoid the problem of “file not found,” when the URL of the file is changed, Kelley indicates that the bookmark database would be updated.

Shteyn relates to a system alerts a mobile user of a service using a local beacon. The local beacon sends what Shteyn calls a “facilitation signal,” which is received by the mobile user’s device. A user profile in the mobile device controls whether the user of the mobile device is actually alerted.

Duri relates to what Duri refers to as “dynamic bookmarks,” which are unlike

conventional bookmarks that have a URL. The “dynamic bookmarks” of Duri are a set of attributes that can be used to obtain a URL. A client sends the attributes to a server and the server replies with a URL or URLs, if any match the attributes in the client’s request.

These largely unrelated references are proposed in the Office Action as disclosing (claim 1) an apparatus including at least one processor and at least one memory including computer program code, the at least one memory and the computer program code configured to, with the at least one processor, cause the apparatus to perform the following:

- store a set of tags and for each tag, store an associated network address, wherein each tag corresponds to a service and wherein the associated network address corresponds to a service provider of the service,
- provide a user interface that enables a user to select one of the tags and cause the apparatus to initiate a connection to the network address associated with the tag,
- estimate the location of the apparatus,
- communicate with the network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location, and
- automatically alter the network address associated with the tag in response to the communication received from the network.

The Office Action alleged that the “tag” in claim 1 is a bookmark in which the “associated network address” is the URL, and that the user of Kelley’s system can select a

bookmark and initiate a connection to the URL listed for that bookmark.

However, there is absolutely no reason in the prior art for estimation of location of the device to be added to Kelley's system, or for any of the other features of the claim to be performed as a consequence of such estimation.

The Office Action cited to Shteyn, but Shteyn's approach has nothing to do with updating bookmarks like those of Kelley. Even if Shteyn discloses estimating a location, Shteyn does not disclose the remaining features because Shteyn does not disclose updating bookmarks (allegedly corresponding to the recited "tags").

The Office Action also cited to Duri, but Duri disparages using bookmarks in favor of using "dynamic bookmarks." (see paragraph [0024] of Duri). If Duri's bookmarks were substituted for Kelley's bookmarks, then Kelley's bookmarks would no longer include a network address, since Duri's bookmarks do not contain such an address.

Moreover, Duri nowhere suggests altering a network address associated with a bookmark (whether conventional or "dynamic"). Accordingly, even if Duri could somehow be combined with Kelley and Shteyn, the combination would still not disclose or suggest all of the elements of the claims.

It is respectfully submitted that the features of the claims have been improperly dissected, in the Office Action, and subjected to a piecemeal rejection, rather than being treated as a whole. MPEP 2142 notes that *prima facie* obviousness requires consideration of the invention as a whole. It is respectfully submitted that there is no way that the invention as a whole could be derived from the teachings of Kelley, Shteyn, and Duri.

There is nothing to lead one of ordinary skill in the art to make the modifications necessary to arrive at the claimed invention except Applicants' own disclosure.

This was explained at much greater length above, as well as in Applicants' Response filed April 25, 2011, pp. 2-14. In response, the Advisory Action of May 16, 2011, provided some additional arguments in support of the rejection. However, the Advisory Action's reasoning is equally subject to clear error.

The Advisory Action asserted that Shteyn provides an XML document that includes URLs for services, and that the XML document is generated based on geographic information. Even assuming that this is true, it has nothing meaningful to do with what Kelley is doing. There's no obvious connection to what Kelley is doing and no obvious way to combine the teachings of the two documents. The only reason Shteyn and Kelley would be combined in the way proposed is simply Applicants' own disclosure. Such a reason is legally insufficient.

The fact that both systems relate to the use of URLs is no basis for one of ordinary skill in the art to combine their teachings in any particular way. Such a basis leads to no specific combination. Moreover, the Office Action and Advisory Action have not merely argued for a simple combination of Kelley and Shteyn, but a modification of Kelley in which certain aspects of Shteyn are taken and others are not. Motivation for such a modification cannot come from the bare fact that Shteyn mentions URLs.

Clear Error 2: Shteyn Does not Teach Altering Addresses Associated with Tags

The Advisory Action alleged that “Shteyn further teaches the feature of changing URL based on location (through GPS estimation).” This is a clear error. There is no discussion in Shteyn about changing a URL based on location. The arguments above and the Response filed April 25, 2011, dealt with the passages of Shteyn cited in the Office Action, but a very simple point can be made this way:

Claim 1 requires: “a communication that automatically alters the network address associated with a tag in dependence on the estimated location.” There is no such communication in Shteyn. The Office Action has not identified such a communication, the Advisory Action has not identified such a communication, and such a communication cannot be found in Shteyn or any of the other prior art of record. It cannot be pointed out, because it does not exist in the prior art.

As explained in more detail above and in the Response filed April 25, 2011, the same or similar clear errors apply to each of independent claims 1, 8, 50, 57, 60, and 61. This final rejection being in error, therefore, it is respectfully requested that this honorable Board of Patent Appeals and Interferences reverse the Examiner's decision in this case and indicate the allowability of application claims 1, 3-10 and 50-61.

In the event that this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees which may be due with respect to this paper may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

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Encls: Appendix 1 - Claims on Appeal
Appendix 2 - Evidence
Appendix 3 - Related Proceedings

APPENDIX 1

CLAIMS ON APPEAL

1. (Previously Presented) An apparatus, comprising:

at least one processor and at least one memory including computer program code, the at least one memory and the computer program code configured to, with the at least one processor, cause the apparatus to

store a set of tags and for each tag, store an associated network address, wherein each tag corresponds to a service and wherein the associated network address corresponds to a service provider of the service,

provide a user interface that enables a user to select one of the tags and cause the apparatus to initiate a connection to the network address associated with the tag,

estimate the location of the apparatus,

communicate with the network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location, and

automatically alter the network address associated with the tag in response to the communication received from the network.

3. (Previously Presented) An apparatus as claimed in claim 1, wherein the user interface has a mode where a user can cause the apparatus to communicate with the network to request transmission of the communication automatically altering the network

address associated with the tag.

4. (Previously Presented) An apparatus as claimed in claim 3, wherein the at least one memory and the computer program code are further configured to, with the at least one processor, cause the apparatus at least to communicate with the network automatically.

5. (Previously Presented) An apparatus as claimed in claim 4, wherein the at least one memory and the computer program code are further configured to, with the at least one processor, cause the apparatus at least to detect a service provider of the network to which the apparatus is connecting, and to communicate with the network in response to a change in the service provider.

6. (Previously Presented) An apparatus as claimed in claim 1, wherein the tag and its associated network address are stored in the memory as a dynamic service card.

7. (Previously Presented) An apparatus as claimed in claim 1, wherein the network address associated with the tag comprises at least one of:

a telephone number;

an email address; or

a uniform resource locator.

8. (Previously Presented) An apparatus, comprising:

at least one processor and at least one memory including computer program code, the at least one memory and the computer program code configured to, with the at least one processor, cause the apparatus at least to

store a set of tags and for each tag, store an associated network address, wherein each tag corresponds to a service and wherein the associated network address corresponds to a service provider of the service, and

communicate at least one instruction containing a tag and an associated network address with at least one mobile communication terminal, wherein

the at least one mobile communication terminal is configured to communicate with the apparatus to request that the apparatus transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location.

9. (Previously Presented) An apparatus as claimed in claim 8, wherein the at least one instruction instructs the mobile communication terminal to automatically alter a network address associated with a tag stored in the mobile communication terminal to the network address associated with a tag stored in the apparatus.

10. (Previously Presented) An apparatus as claimed in claim 8, wherein the at least one memory and the computer program code are further configured to, with the at

least one processor, cause the apparatus at least to store a list of associated tags for one or more of the at least one mobile communication terminal, wherein

the apparatus is configured to instruct the one or more of the at least one mobile communication terminal only to alter the network addresses associated with the tags associated with the mobile communication terminal identified in the list.

50. (Previously Presented) A method, comprising:

storing a set of tags and for each tag, storing an associated network address, wherein each tag corresponds to a service and wherein the associated network address corresponds to a service provider of the service;

providing a user interface that enables a user to select one of the tags and cause a mobile communication terminal to initiate a connection to the network address associated with the tag;

estimating the location of the mobile communication terminal;

communicating with the network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location; and

automatically altering the network address associated with the tag in response to the communication received from the network.

51. (Previously Presented) A method as claimed in claim 50, further comprising:

estimating the location of the mobile communication terminal, wherein
the mobile communication terminal is configured to communicate with the network
to request the network to transmit a communication automatically altering the network
address associated with a tag in dependence on the location estimated by the mobile
communication terminal.

52. (Previously Presented) A method as claimed in claim 51, wherein the user
interface has a mode where a user can cause the apparatus to communicate with the
network to request transmission of the communication automatically altering the network
address associated with the tag.

53. (Previously Presented) A method as claimed in claim 52, wherein the mobile
communication terminal communicates with the network automatically.

54. (Previously Presented) A method as claimed in claim 53, further comprising:
detecting a service provider of the network to which the mobile communication
terminal is connecting, and to communicate with the network in response to a change in the
service provider.

55. (Previously Presented) A method as claimed in claim 50, wherein the tag and
its associated network address are stored as a dynamic service card.

56. (Previously Presented) A method as claimed in claim 50, wherein the network address associated with the tag comprises at least one of:

a telephone number;

an email address; or

a uniform resource locator.

57. (Previously Presented) A method, comprising:

storing a set of tags and for each tag, storing an associated network address, wherein each tag corresponds to a service and wherein the associated network address corresponds to a service provider of the service; and

communicating at least one instruction containing a tag and an associated network address with at least one mobile communication terminal, wherein

the at least one mobile communication terminal is configured to communicate with a network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location.

58. (Previously Presented) A method as claimed in claim 57, wherein the at least one instruction instructs the mobile communication terminal to automatically alter a network address associated with a tag stored in the mobile communication terminal to the network address associated with a tag stored in a network element.

59. (Previously Presented) A method as claimed in claim 57, further comprising:
storing a list of associated tags for one or more of the at least one mobile communication terminal, and

instructing the one or more of the at least one mobile communication terminal only to alter the network addresses associated with the tags associated with the mobile communication terminal identified in the list.

60. (Previously Presented) A computer program embodied on a non-transitory computer-readable storage medium, the program configured to control a processor to:

store a set of tags and for each tag, store an associated network address, wherein each tag corresponds to a service and wherein the associated network address corresponds to a service provider of the service;

provide a user interface that enables a user to select one of the tags and cause a mobile communication terminal to initiate a connection to the network address associated with the tag;

estimate the location of the mobile communication terminal;

communicate with the network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location; and

automatically alter the network address associated with the tag in response to the

communication received from the network.

61. (Previously Presented) A computer program embodied on a non-transitory computer-readable storage medium, the program configured to control a processor to:

store a set of tags and for each tag, store an associated network address, wherein each tag corresponds to a service and wherein the associated network address corresponds to a service provider of the service; and

communicate at least one instruction containing a tag and an associated network address with at least one mobile communication terminal, wherein

the at least one mobile communication terminal is configured to communicate with a network to request that the network transmit a communication that automatically alters the network address associated with a tag in dependence on the estimated location.

APPENDIX 2

EVIDENCE APPENDIX

No evidence under section 37 C.F.R. 1.130, 1.131, or 1.132 has been entered or will be relied upon by Appellants in this appeal.

APPENDIX 3

RELATED PROCEEDINGS APPENDIX

No decisions of the Board or of any court have been identified under 37 C.F.R. §41.37(c)(1)(ii).